

REMARKS

New Matter Objection

The examiner's objection to the amendments made in paragraph 14 of the specification as constituting "new matter" is respectfully traversed.

The objected-to language, according to the examiner, is: "during the deposit or money receiving portion of the ongoing money deposit transaction", which the examiner contends implies some limitation of the different portions of the ongoing money deposit transaction which was not encompassed by the original filed disclosure.

A review of the originally filed disclosure begins with a review of the single figure of drawings submitted with the original application, wherein the checking device 5 is shown immediately following the input bin 3, thereby requiring that all banknotes inserted during an ongoing money deposit transaction must pass through the checking device before they are routed to an appropriate storage pocket 6, 7 or 8.

Paragraph [0013] of the specification explains:

...the banknotes BN inserted as bundles into the pocket 3 are transported separately through a checking device 5 in which they are checked as to certain physical and/or chemical properties. The checking device 5 beside (*sic*) checking currency, denomination and authenticity in particular serves for determining the state of the inserted banknotes BN. This means, that in the checking device 5 it is checked e.g. whether the bank notes BN are worn, soiled, damaged or changed in any other fashion, which would oppose a further use of the banknotes BN in the money circulation.

As further stated in paragraph [0014]:

In dependence on the result of the checking, the bank notes BN then are supplied to one or three possible storage pockets 6 to 8. [...]This can mean, for example, that all those bank notes are dispensed into the storage pocket 7, which the checking device 5 recognizes to be only little soiled and/or little worn and/or little damaged. All other bank notes BN, which the checking device 5 accepts to be authentic, are transported into the third storage pocket 8, which serves as intermediate storage device. (emphasis added)

The specification further explains that after this processing of the banknotes BN, which the operator has inserted into the input pocket 3 during the deposit

transaction, the operator has at his disposal all those banknotes of the deposit transaction, the state of which is so good, that they are suitable for further circulation in the circulation of money (paragraph [0015]).

The specification further states in paragraph [0016]:

After all the bank notes inserted into the input pocket 3 have been checked and distributed into the three storage pockets 6 to 8... the operator by means of a display and input unit 9 is requested, for example by displaying a respective text or the flashing up of a pertinent symbol in the form of a pictograph, *to complete the money deposit transaction.*

In accordance with paragraph [0019]:

When the operator, however, wishes to interrupt *an ongoing money deposit transaction* and does not wish the bank notes BN located in the storage pocket 8 being finally stored in the bank note cassette 10, *he can cancel the individual operation by means of the display and input unit 9.*

Paragraph [0021] of the specification describes how the operator may determine certain criteria for the dispensing of the banknotes that have been inserted into the apparatus. This paragraph describes how certain banknotes may be deposited in a storage pocket 7 following a fitness check by the checking device 5 in advance of the storage pocket 7, as shown in the drawing, or in storage pocket 8, likewise after a fitness check, and ultimately into banknote cassette 10. Clearly in accordance with this paragraph the dispensing of the banknotes from the various storage pockets can only occur after the banknotes have been checked for fitness by the checking device 5, which is upstream of all of the storage pockets and the banknote cassette.

From the drawings and the specification, Applicant submits that a person skilled in the art would be clearly informed that (i) there is a money insertion or receiving portion of an ongoing deposit transaction in the apparatus originally disclosed in the application, (ii) during the initial money insertion portion of the ongoing deposit transaction, all bills inserted for deposit must be checked for fitness by the fitness check device 5 before any of the bills are deposited in any pockets or cassette of the apparatus; and (iii) the money insertion and receiving procedure must occur before there can be any money dispensed from the apparatus because

all the money inserted and received by the apparatus is transported to a temporary storage pocket after a fitness check has been made of the money inserted and received into the apparatus.

The objected-to amendment language accordingly does not constitute new matter, since it merely describes what is shown in the drawing figure and what has already been described in other portions of the original specification and claims. Throughout the specification and original claims, reference is made to the money being checked for currency, denomination, authenticity and *fitness* following insertion of the banknotes into the apparatus at the input pocket 3. The fitness check is carried out immediately following insertion of the banknotes in the input pocket 3 (paragraph [0013]) before the money is transported to any of the temporary storage pockets (paragraph [0014]). Accordingly, Applicant submits that the originally filed written description clearly establishes proper antecedent basis for distinguishing the ongoing money deposit transaction as having a money insertion or receiving portion of the transaction as opposed to a cash dispensing portion of the transaction. The written description and drawing throughout clearly teach that the fitness checking of the money must occur while the money is being received in the apparatus. Any other conclusion would be illogical and unsupported by the original disclosure.

The purpose of the amendment, as previously explained to the examiner, is simply to identify the timing of the fitness check of the received money in accordance with the method and apparatus disclosed in this application, as distinguished from the method and apparatus disclosed in the Watanabe patent, relied on by the examiner in rejecting the previously presented claims. The examiner is understood to agree that Watanabe discloses fitness checking of bills received in the apparatus described in the patent only during a cash dispensing procedure and not during a cash receiving part of the transaction.

The proposed language "during the deposit or money receiving portion of the ongoing money deposit transaction" is entirely consistent with and in conformity with the original disclosure for reasons given above. Applicant, accordingly, contends that a person skilled in the art would understand from the originally filed written

description that there is an initial money insertion or receiving activity constituting a part of an ongoing money deposit transaction as distinguished from a cash dispensing part of the money deposit transaction.

The examiner's attention is also directed to paragraph [0017] of the written description wherein the operator must confirm which deposited notes are to be finally withheld and which notes in the storage pocket 8 will be transported into a banknote cassette (item 10 in the drawing). The description states: "*for completing the ongoing transaction the deposit data are passed on to a central bank office....*" The language "for completing the ongoing transaction" can only be interpreted by a skilled person as meaning that the ongoing transaction has not yet been completed at the time that the operator must determine which banknotes are to be transported to the cassette. As noted previously, banknotes in the storage pocket 5 already *have been checked for fitness*. Since the ongoing transaction has not yet been completed, it is appropriate for Applicant to designate that portion of the ongoing transaction that has occurred up to that point as a portion of the ongoing transaction that corresponds with a money insertion and receiving portion of the ongoing deposit transaction. Applicant submits to interpret this language otherwise defies logic and common sense. The original description thus provides ample support for the language in the currently presented claims characterizing a portion of the deposit transaction as a "deposit or money receiving portion of the ongoing deposit transaction".

Applicant submits that withdrawal of the objection to the language "during the deposit or money receiving portion of the ongoing money deposit transaction" be withdrawn and that such withdrawal request applies to each and every amendment containing these words or the equivalent.

Claim Rejections – 35 U.S.C. §112

Withdrawal of the claim rejections under 35 U.S.C. §112 grounded on the examiner's perception of new matter introduced into the specification and claims by the language "during a deposit or money receiving portion of the deposit transaction" is requested for the reasons given above. Specifically, the quoted language cannot

constitute new matter based on the fact that a skilled person would understand from the originally filed written description that there is a money insertion or deposit receiving portion of each ongoing money deposit transaction as distinguished from a cash dispensing portion of such transaction. Applicant accordingly maintains that the claims are in conformity with 35 U.S.C. §112 in all respects.

Claim Amendments

The claim amendments proposed herein pursuant to 35 U.S.C. §116 do not add any substantial new issues that would require detailed consideration by the examiner, given the remarks accompanying the response to the previous Office communication and in view of the personal interview conducted with the examiner by Applicant's attorney on March 9, 2010. During that personal interview, the recollection of Applicant's attorney is that the examiner acknowledged the fact that Watanabe teaches checking of banknotes submitted for deposit only during a cash dispensing procedure carried out by the apparatus of the patent. The amendments currently proposed are intended only to clarify the language of the claims as previously presented to avoid any possible doubt as to the timing of the money fitness check carried out by element 5 in the drawing of this application. Moreover, many of the amendments are intended only to make the claim language consistent with the previously presented claim language. For example, the term "ongoing money deposit transaction" has appeared in the claims since the early stage of examination and reference to a money receiving portion of the ongoing deposit transaction was expressed in the previously presented claims. Accordingly, Applicant submits that the amendments are largely cosmetic and do not raise any issues that would require further searching or detailed consideration following the close of prosecution of the application.

Claim Rejections – 35 U.S.C. §102

As noted above, the examiner and Applicant both recognize that Watanabe does not check deposited banknotes for fitness during a money receiving portion of an ongoing deposit transaction (Watanabe: c.7, l.61-63). All the banknotes inserted

into the apparatus of Watanabe are placed in temporary storage spaces 27, 28 and 29 which share common pockets with money deposited during a previous transaction. During a cash dispensing operation, bills are withdrawn from the temporary storage spaces 28 and 29 of the first and second storage sections 16 and 15 and are returned to the teller after a fitness check of the bills (*id*, c.11, l.59-63).

Thus, Watanabe lacks an element recited in the claims as currently presented, namely the second step recited in claim 1:

During the deposit of money receiving portion of the ongoing deposit transaction, checking the inserted banknotes by a checking device of the apparatus at least as to authenticity and the state of the banknotes and *determining fitness for circulation of said banknotes as a result of the checking*.

Likewise, with regard to independent claim 8, Watanabe lacks an element of the apparatus recited in this claim as currently presented by failing to disclose:

A checking device arranged to check banknotes inserted into the input pocket at least as to authenticity and state of the banknotes *and to determine fitness for circulation of said banknotes during the deposit or money receiving portion of the ongoing money deposit transaction*.

The statement by the examiner in rejecting claims 1-6 and 8-12 under 35 U.S.C. §102 in view of Watanabe to the effect that Watanabe discloses: "transporting at least parts of the banknotes which were recognized as not fit for circulation by the checking device into a storage pocket of the apparatus not accessible by the operator *during the deposit or money receiving portion of the deposit transaction*" is not accurate and is unsubstantiated by the actual disclosure of Watanabe. As noted above, Watanabe fails to show, teach or remotely suggest checking banknotes inserted during a money deposit transaction while the money is being received into the apparatus.

Failing the necessary evidence needed to establish lack of novelty, withdrawal of the rejection of claims 1-6 and 8-12 of this application under 35 U.S.C. §102 is appropriate and the same is respectfully requested.

Claim Rejections – 35 U.S.C. §103

The rejection of claims 1-13 under 35 U.S.C. §103(a) as unpatentable over the basic reference WO 02/50784 (Matzig) in view of Watanabe is respectfully traversed for the basic reasons given above with regard to the rejection of claims 1-6 and 8-12 under 35 U.S.C. §102 based on the teachings of Watanabe alone.

The basic reference Matzig fails to disclose or teach a method as recited in claim 1 or apparatus as recited in claim 8 that processes and transports unfit banknotes that were checked during a money receiving portion of a transaction first to a not accessible storage pocket and subsequently into a not accessible banknote cassette within the apparatus. Watanabe, as discussed above, never checks fitness of incoming banknotes and, accordingly, there is no disclosure of a subsequent disposition of the unfit banknotes apart from a fitness check that is conducted only upon *dispensing* of the banknotes that were previously deposited in the apparatus and routed to temporary storage spaces.

As Applicant noted in the response to the previous Office communication, the manner in which the teachings of Watanabe could somehow be merged into the teachings of Matzig to result in the method and apparatus recited in claims 1 and 8 of this application is highly open to speculation and appears to involve hindsight based on Applicant's disclosure. One possible end result of such a merger would be that the Matzig basic apparatus would be modified in accordance with Watanabe to delay checking the received banknotes for fitness until a cash dispensing procedure is carried out, which would be contrary to the teachings of Matzig itself. Matzig has no apparatus available to check unfit or other banknotes during a money dispensing operation and the examiner has not explained why or how a person skilled in the art would be motivated to modify Matzig in accordance with this aspect of the Watanabe teachings.

While the examiner suggests another possible manner in which Matzig could be modified in accordance with the teachings of Watanabe, namely storing unfit notes in a not-accessible pocket, a person skilled in the art would be faced with modifying the complete banknote transportation system of Matzig in order to produce the result expected by the examiner. There simply is no basis apparent to

Applicant for modifying Matzig in the drastic manner suggested by the examiner, which would require extraction of only a single portion of the apparatus and methodology described in Watanabe while ignoring the remainder of the system necessary for operation of the Watanabe apparatus. Notably, in Watanabe the banknotes stored in the non-accessible pockets have not been checked for fitness until they are being dispensed, not during a receiving portion of the deposit transaction. Such extraction of selected bits and pieces of a prior art reference without clear evidence that such modification would be readily apparent and obvious to a person skilled in the art is contrary to examination rules. In summary, Applicant submits that the examiner has failed to establish a *prima facie* case of obviousness in the rejection of claims 1-13 as being unpatentable over Matzig in view of Watanabe and withdrawal of the rejection is respectfully requested.

Examiner's Response to Applicant's Arguments

In the examiner's response to Applicant's arguments expressed in the response to the last Office communication, the examiner essentially characterizes Matzig as transporting unfit bills to an output tray, while Watanabe shows that the bills could be transported to a not accessible storage space (space 27 in Watanabe).

The examiner overlooks the fact that the temporary storage space 27 in Watanabe not only receives unfit bills, but receives authentic bills as well in a space 27 constituting part of storage section 14 which also contains bills from a previous transaction. Bills withdrawn from the space 27 during a cash dispensing transaction are reviewed for authenticity and fitness, with unfit bills being returned to the temporary holding space 27 (Watanabe: c.12, l.6-9).

Thus, the method of handling unfit bills in Watanabe is considerably different than the method of handling unfit bills in Matzig and the respective apparatuses described in the patents are correspondingly different. Applicant submits that the extent of the differences supports Applicant's position that a person skilled in the art would not be motivated to modify Matzig by providing a not accessible storage bin for unfit notes using the teachings of Watanabe, because the teachings of Watanabe would lead the skilled person to modify Matzig drastically to provide a

Application No.: 10/550,494
Attorney Docket: MATZ3004/JEK
Art Unit: 3653

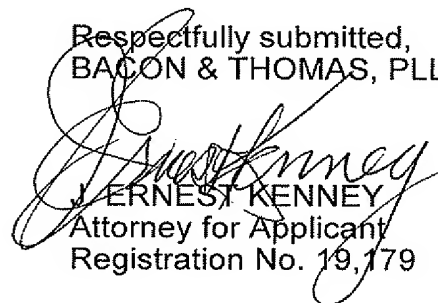
storage space like the storage space 14 of Watanabe that contains both previously deposited bills and currently deposited bills, including unfit notes that have not been checked for fitness. Moreover, Matzig as modified by Watanabe would require a complete transport system that would direct unchecked-for-fitness deposited bills to be placed in the not accessible storage space of a storage area containing previously deposited bills and a transport system for withdrawing bills from the temporary storage space and then recycling them back to the storage space if they are deemed to be unfit for circulation. Such a complex maneuver in Matzig would drastically change the basic apparatus and methodology described in Matzig.

It is incumbent upon the examiner, if the rejection is to be maintained, to fully explain in detail how the skilled person would modify Matzig in a manner involving the provision of both a transport system and a temporary holding area containing both previously deposited bills and newly deposited bills (both fit and unfit) in a manner that would enable the transport apparatus to withdraw bills from the temporary storage space, check them for fitness, and then return them to the temporary storage space, and then to equate such a system with the claims under consideration.

Applicant submits that the examiner's reasoning in this regard is flawed and fails to support the rejection of the claims under 35 U.S.C. §103(a). Withdrawal of the rejection is requested.

The application having been placed fully in condition for allowance, withdrawal of the final rejection is requested, with passage of the application to issue.

Respectfully submitted,
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Date: June 25, 2010